

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Lykos

Mailed: December 22, 2005

Opposition No. 91122000

AMAZON.COM, INC.

v.

VON ERIC LERNER KALAYDJIAN

Before Bucher, Drost and Zervas, Administrative Trademark
Judges.

By the Board:

On March 8, 2000, applicant (proceeding pro se) applied to register the mark COSMETICSAMAZON for "retail store and on-line ordering services featuring skin tanning preparations, namely, lotions, creams, gels and oils, sunblock lotion to be applied to the skin and lips, cosmetics and skin cleaning preparations, namely, facial soap, body soap, bath oil, hair shampoos and conditioners, skin lotions, face and body cleansers, colognes, eau de toilette, and perfume" in International Class 35, alleging a bona fide intent to use the mark in commerce.¹ On February 3, 2001, opposer filed a notice of opposition against applicant's application on the grounds that applicant's

¹ Application Serial No. 75938128.

applied-for mark (1) so resembles opposer's previously used and registered marks that they are likely to cause confusion, mistake, or deceive prospective consumers under Section 2(d) of the Lanham Act; and (2) dilutes the distinctive quality of opposer's marks under Section 43(c) of the Lanham Act as amended. In the notice of opposition, opposer pleaded ownership of the following registered marks:

AMAZON.COM for "computerized on line ordering service featuring the wholesale and retail distribution of books" in International Class 35;²

AMAZON.COM for "computerized on line search and ordering service featuring the wholesale and retail distribution of books, music, motion pictures, multimedia products and computer software in the form of printed books, audiocassettes, videocassettes, compact disks, floppy disks, CD ROMs, and direct digital transmission" in International Class 35;³ and

AMAZON.COM BOOKS for "computerized on line ordering service featuring the wholesale and retail distribution of books" in International Class 42.⁴

² Registration No. 2078496, registered on July 15, 1997, alleging April 15, 1995 as the date of first use anywhere and in commerce, Section 8 affidavit accepted and Section 15 affidavit acknowledged.

³ Registration No. 2167345, registered on June 23, 1998, alleging April 15, 1995 as the date of first use anywhere and in commerce, Section 8 affidavit accepted and Section 15 affidavit acknowledged.

⁴ Registration No. 2078494, registered on July 15, 1997, alleging April 15, 1995 as the date of first use anywhere and in commerce, Section 8 affidavit accepted and Section 15 affidavit acknowledged, with a disclaimer of BOOKS.

Opposer did not plead ownership of any other registrations,⁵ prior trademark use or prior use analogous to trademark use in the notice of opposition.

This case now comes up for consideration of opposer's (1) motion for summary judgment on opposer's claims of likelihood of confusion and dilution; and (2) motion for sanctions. The motion for summary judgment is contested.

The Board has carefully reviewed the parties' respective arguments and accompanying exhibits, although the Board has not repeated the parties' complete arguments in this order.

I. Opposer's Motion for Summary Judgment

First, the Board will consider opposer's motion for summary judgment. Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986). In a motion for summary judgment, the evidentiary record and all reasonable inferences to be

⁵ Opposer did, however, plead ownership of numerous applications.

drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

A.Opposer's Motion for Summary Judgment on Opposer's Claim of Likelihood of Confusion

In order to prevail on a claim of likelihood of confusion on summary judgment, opposer must prove the absence of a genuine issue of material fact (1) that applicant's mark, as applied to its goods or services, so resembles opposer's trademark or trade name as to be likely to cause confusion, mistake, or deception; and (2) priority of use. *See Fed. R. Civ. P. 56(c); see also, King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

In moving for summary judgment on this claim, opposer states that on January 24, 2000, prior to the filing date of applicant's application, opposer announced a business alliance with another Internet retail provider in the field of health, beauty and personal products. Opposer, did not rely on the three registrations pleaded in its notice of opposition, but rather relies on the following three registrations which were not pleaded, as a basis for refusing registration under Section 2(d):

Registration No. 2837138 for AMAZON.COM for automated and computerized trading of goods and online mail ordering services featuring, among

other things "soaps, perfumery, cosmetics" and "cosmetic utensils;" filed April 27, 2000; registered April 27, 2004; and alleging November 14, 2000 as the date of first use anywhere and in commerce;

Registration No. 2832943 for AMAZON for electronic retailing services via computer and an online searchable database featuring among other things "soaps, perfumery, cosmetics" and "cosmetic utensils;" filed April 21, 2000; registered April 13, 2004; alleging October 31, 2001 as the date of first use anywhere and in commerce; and

Registration No. 2649373 for AMAZON.COM OUTLET for electronic retailing services via computer and an online searchable database featuring among other things "soaps, perfumery, cosmetics" and "cosmetic utensils;" filed March 22, 2000, registered November 12, 2002; alleging March 15, 2000 as the date of first use anywhere and in commerce.

As a threshold matter, it is well established that a party may not obtain summary judgment on an unpleaded issue. See Fed. R. Civ. P. 56(a) and 56(b); *S. Industries, Inc. v. Lamb-Weston, Inc.*, 45 USPQ2d 1293 (TTAB 1997). However, opposer's notice of opposition does not assert Registration Nos. 2837138, 2832943 and 2649373⁶ and is devoid of any allegations regarding priority of use with respect to the marks and services contained in these registrations. The notice of opposition is also silent regarding the business alliance with the other Internet retailer mentioned above. Opposer is therefore precluded from relying on Registration Nos. 2837138, 2832943 and 2649373 and on common law usage as

evidence of prior use. Prior to filing the instant summary judgment motion, opposer should have moved to amend its pleading in order to properly rely on these registrations. See e.g. *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993).

Insofar as opposer has sought summary judgment on unpleaded grounds, opposer's motion for summary judgment on the claim of likelihood of confusion is denied.

B. Opposer's Motion for Summary Judgment on Dilution

Turning next to opposer's claim of dilution under Section 43(c) of the Lanham Act as amended, Section 43(c)(1) of the Trademark Act, 15 U.S.C. § 1145, provides that "[t]he owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection." This ground is made available for opposition proceedings by Section 13(a) of the Act. Pursuant to the Act and the case law, the Board must consider when opposer's mark purportedly became famous in determining whether applicant's mark

⁶ The Board acknowledges that the underlying applications which these registrations are based upon did not mature into registration until after opposer filed its notice of opposition.

dilutes opposer's pleaded mark(s). *See Toro Co. v. Torohead Inc.*, 61 USPQ2d 1164 (TTAB 2001). Where an intent-to-use application is the subject of an opposition, the opposer must establish that its mark became famous prior to the filing date of the application. *See Id.* In addition, in determining whether a mark has attained the requisite fame and distinctiveness to meet the standard for dilution, the following factors are considered:

- (A) the degree of inherent or acquired distinctiveness of the mark;
- (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (C) the duration and extent of advertising and publicity of the mark;
- (D) the geographical extent of the trading area in which the mark is used;
- (E) the channels of trade for the goods or services with which the mark is used;
- (F) the degree of recognition of the mark in the trading areas and channels of trade used by the mark's owner and the person against whom the injunction is sought;
- (G) the nature and extent of use of the same or similar marks by third parties; and
- (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register. *See Id.*

After reviewing the record, we find that opposer has failed to introduce sufficient evidence of fame of its mark prior to applicant's filing date. As such, a genuine issue of material fact exists as to the fame of opposer's mark, and opposer's motion for summary judgment on its claim of

dilution is denied as well.⁷

II. Opposer's Motion for Sanctions

On April 12, 2005, the Board ordered applicant to serve a response to opposer's Interrogatory No. 1 in opposer's first set of interrogatories. According to opposer, applicant has failed to respond. As a sanction for applicant's failure to meet his discovery obligations, opposer has requested that the Board preclude applicant from introducing any evidence at trial responsive to opposer's Interrogatory No. 1.

The Board is not in receipt of any brief in opposition to opposer's motion for sanctions. Applicant therefore has conceded opposer's motion pursuant to Trademark Rule 2.127(a).

Opposer's motion is also well taken. Trademark Rule 2.120(g) provides the Board with the discretion to impose sanctions against a party failing to comply with a Board order compelling discovery. The Board may entertain various forms of sanctions, including the preclusion of evidence at trial. See TBMP § 527.01(a) (2d ed. rev. 2004) and cases

⁷ The parties should note that all evidence submitted in support of and in opposition to applicant's motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial periods. See *Levi Strauss & Co. v. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); and *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983).

cited therein; *c.f.* Fed. R. Civ. P. 37(c)(1).

Insofar as applicant failed to comply with the Board's April 12, 2005 order, and conceded opposer's motion for sanctions, opposer's motion for sanctions is granted. Applicant is hereby precluded from introducing any evidence at trial responsive to opposer's Interrogatory No. 1 in opposer's first set of interrogatories. The interrogatory reads as follows:

To the extent YOUR response to any of the Requests for Admission set forth in the accompanying Opposer's First Set of Requests for Admission to Applicant is anything other than an unqualified admission, please (i) state all facts upon which YOUR refusal to admit is based; (ii) IDENTIFY all PERSONS with knowledge of such facts; (iii) IDENTIFY all DOCUMENTS that support YOUR refusal to admit.

Applicant is therefore precluded at trial from introducing the testimony of persons with knowledge of, as well as all documents relating to, applicant's denials (or qualified admissions) of opposer's first set of requests for admission.

The imposition of the aforementioned sanction does not, however, mean that applicant is effectively barred from defending against opposer's claims in this case. Indeed, applicant may rest on his application in putting forth his defense. As such, any motion for summary judgment filed by opposer on the basis of this sanction would be denied by the Board.

III. Trial Dates Reset

Proceedings herein are resumed and trial dates, including the period for discovery, are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close:	3/5/06
30-day testimony period for party in position of defendant to close:	5/4/06
15-day rebuttal testimony period for plaintiff to close:	6/18/06

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b).

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.